

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Lazaridis et al
Title : SYSTEM AND METHOD FOR IMPLEMENTING A
NATURAL LANGUAGE USER INTERFACE
Application No. : 10/768,509
Confirmation No. : 6885
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Group Art Unit : 2626
Attorney Docket : 555255-012690

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REPLY BRIEF

This Reply Brief is in response to the Examiner's Answer mailed 12/2/09.

Any fee due for this submission should be charged to the Jones Day Deposit Account No.
501432, reference 555255-012690.

(I) STATUS OF CLAIMS

Claims 2, 5-13, 37, 41-45, 48-50 and 56 are all pending, finally rejected and currently being appealed. Claims 1, 3, 4, 14-36, 38-40, 46, 47, and 51-55 are cancelled.

(II) GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

Claims 2, 5, 9-13, 37, 41-45 and 48-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,974,413 (hereinafter referred to as “the Beauregard Reference” or “Beauregard”) in view of non-patent reference Eide, *Valet: An Intelligent Unix Shell Interface*, Master’s Thesis, University of Utah, August 1995 (hereinafter referred to as “the Eide Reference” or “Eide”) and further in view of U.S. Patent No. 6,288,718 (hereinafter referred to as “the Laursen Reference” or “Laursen”). Claims 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beauregard in view of Eide in view of Laursen and further in view of U.S. Patent No. 6,622,119. Claim 56 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Beauregard in view of U.S. Patent No. 7,216,292 (hereinafter referred to as “the Snapper Reference” or “Snapper”). Claims 48-50 are rejected under 35 U.S.C. § 112, as a new ground of rejection in the Examiner’s Answer. These rejections are appealed.

(III) ARGUMENTS

Rejection of claims 48-50 under 35 USC 112

Independent claim 48 recites initiating a software operation “without the user having entered a delimiter denoting an end of the text string.” The Examiner’s Answer (p.14; p.23-24) asserts this limitation is not supported by the specification. Applicants respond that this limitation is indeed supported in the application by the following passages in conjunction with Fig. 6 (below):

“For example, the user may chose ... “e_j” to always represent the user command 'email jim.' In this manner, **only two key strokes** are required to invoke the email composer application 34, and select the addressee 'jim.'” (application, p.9, lines 1-5, emphasis added)

“[T]he natural language search engine 32 will **display a list** of possible commands to the user in step 86. In step 88, the user may select from the list of possible commands, or alternatively **may narrow the list by entering more text.**” (application, p.8, lines 2-4, emphasis added)

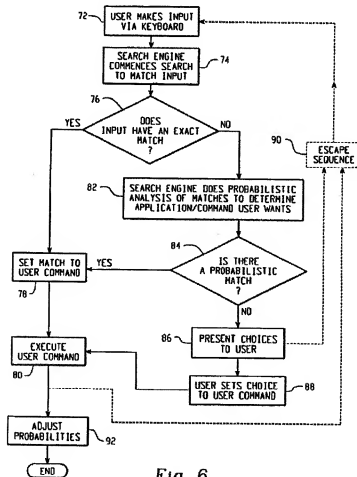


Fig. 6

The above portions of the specification describe the user entering only “e_j” such that “**only two key strokes** are required to invoke the email composer application”, after which the user may enter more text. This clearly discloses, in positive language, the negative limitation of a list being displayed “without the user having entered a delimiter denoting an end of the text string.”

The Examiner’s Answer (p. 14) argues that “the specification does not use or define the term ‘delimiter.’” Applicants respond that there is no requirement to limit the claim lexicon to words found in the Description, but only that the limitation be supported in the original disclosure. As the MPEP explains:

“Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, ... The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter. (MPEP 2163.07(I))

Since “delimiter” is an art recognized word with a single dictionary definition (www.dictionary.com defines it as “a blank space, comma, or other character or symbol that indicates the beginning or end of a character string, word, or data item.”) that matches its usage in the limitation “a delimiter denoting an end of the text string”, this limitation is proper.

The Examiner’s Answer (p. 14) argues that “the specification does not ... contemplate that a delimiter could even be used to denote the end to an entry of an abbreviated textual command. As such, the specification does not disclose the ability to exclude such a command-ending delimiter.” Applicants respond that since the specification clearly supports the claim limitation of initiating an application **without** a delimiter being entered, it does not need to contemplate the unclaimed scenario where a delimiter is entered.

The Examiner’s Answer (p. 14, last par.) quotes a paragraph of MPEP 2175.05(i). This paragraph starts with: “Any negative limitation or exclusionary proviso must have basis in the original disclosure.” Applicants respond that the subject limitation does indeed have basis in the original disclosure as explained above with quotations from the specification.

The MPEP paragraph quoted by the Examiner continues: “If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, ...([the] specification, having described the whole, necessarily described the part remaining.’).” This actually supports Applicants’ position as follows: In *In re Johnson*, the specification listed about 50 chemical functional groups that could be **included** in a polyether. The contested claim was amended during prosecution to overcome prior art by adding a negative limitation that **excluded** two of those functional groups (by reciting “may not both include a divalent sulfone group and may not both include a divalent carbonyl group”) even though there was no support in the specification for excluding those two functional groups. The court sided with the applicant that this negative limitation, excluding two of the disclosed functional groups, may be appended to the claim in order to circumvent the prior art even though the negative limitation was neither stated in the specification nor anticipated by the applicants when drafting the application. Applicants assert that the present negative limitation (of initiating an operation without entering a delimiter) has even better support from the specification than the negative limitation of *In re Johnson*, since the present specification clearly describes a scenario where a delimiter is actually excluded.

The MPEP paragraph quoted by the Examiner continues: “See also *Ex parte Grasselli*, ... The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.” This, too, supports Applicants’ position. That is because the subject negative limitation (of initiating an operation without entering a delimiter) is clearly disclosed in the specification as explained above.

In conclusion, the 112 rejection should be withdrawn, because it is supported in the specification, and the portions of the MPEP quoted by the Examiner strengthen Applicants' position that support from the specification does not need to be phrased with the same wording or negative format as the limitation.

Rejection of Independent Claim 2

Claim 2 recites the step of "while receiving the abbreviated textual command, performing the steps of... displaying a list of probable complete commands matching the currently received portion of the abbreviated textual command." The Examiner's Answer (last par. of p. 17 through p. 18) clarifies that the rejection is based on the Examiner's assertion that Eide, not Beauregard, discloses this limitation.

The Appeal Brief noted that this limitation (of displaying a command list "while receiving the abbreviated textual command") requires the command list to be displayed **without** the user entering an indication that the text command has been completely entered (*e.g.*, by pressing enter or some other type of delimiter denoting an end of the text string) and noted that Eide contradicts this limitation by **requiring** the user to denote end the text entry with a Tab before a list is displayed. The Examiner's Answer (p. 16, 1st par.) objects to the phrase "without ... (*e.g.*, by pressing ... string)" in Applicants' argument as not being recited in the claim. Applicants respond that although it is not recited in the claim, it is a requirement of the subject limitation (of displaying a command list "while receiving the abbreviated textual command") that is contradicted by Eide.

To avoid the Examiner's objection to how Applicants phrased their argument, Applications can rephrase the argument simply as follows: The subject limitation recites displaying a command list "**while** receiving the abbreviated textual command". This is contradicted by Eide's displaying a list only **after** the text entry is followed by a Tab that signals an **end** to receiving command text.

Claim 2 recites another limitation that is absent from the cited art, that after the command list is displayed, the user enters remaining characters of the command to narrow the list. The Examiner's Answer (p.18, last par.) argues that this is a familiar feature of cell phone address books. Applicants respond that applying this feature to a list of cell phone addresses would not make it obvious for entering software commands as claimed, in addition to the Examiner not having demonstrated that this feature preceded the present application's 6/30/00 provisional priority date.

The Examiner cites Laursen as teaching this limitation (of entering remaining characters of the command after the command list is displayed to narrow the list). The Appeal Brief noted that Laursen does not narrow a list of **commands**, but instead narrows a list of **records** (col. 1, line 15) exemplified as names in an address list. And the Appeal Brief (p.11-12) listed four reasons why the skilled person would not have applied Laursen's method of narrowing a list of names to Beauregard's command-processing system to arrive at claim 2.

The Examiner's Answer (p.20-22) argues that the skilled person would have applied Laursen's method to Beauregard because both references relate to text entry. Applicants respond that the four reasons listed in the Appeal Brief (p.11-12) explain why there would still be minimal motivation and likelihood of success to apply the method of Laursen's name listing system to Beauregard's command-processing system.

The Examiner's Answer (p.20, line 10) argues that "In Beauregard, the letters of the text-based command words **could easily** be processed in the same fashion [as Laursen]." Applicants respond that it would not be as "**easily**" processed in Beauregard due to the four reasons listed in the Appeal Brief (p.11-12). And also the question is not whether the skilled person "could" have applied Laursen's method to Beauregard but whether the skilled person "would" have.

Independent Claim 37

The Examiner's Answer applies his arguments regarding claim 2 to claim 37. Applicants' responses to these are the same as made regarding claim 2.

Independent Claim 56

Claim 56 recites the method step of "displaying a list of frequently used commands from the database as soon as the user begins entering the command text string." The Examiner asserts this is taught by Snapper. The Appeal Brief (p.16-17) listed four reasons why the skilled person would not have applied Snapper's method of entering personal information to Beauregard's command-processing method to arrive at claim 2.

The Examiner's Answer (p.26) argues that the skilled person would have applied Snapper's method to Beauregard because both references relate to text entry. Applicants respond that the four reasons listed in the Appeal Brief (p.16-17) explain why there would still be minimal motivation and likelihood of success applying the method Snapper's personal information method to Beauregard's command-processing system.

The Examiner's Answer (p.27, line 9) argues that "In Beauregard, the letters of the text-based command words **could easily** be processed in the same fashion [as Snapper]." Applicants respond that it would not be as "**easily**" processed in Beauregard due to the four reasons listed in the Appeal Brief (p.16-17). And also the question is not whether the skilled person "could" have applied Snapper's method to Beauregard to whether the skilled person "would" have.

Respectfully submitted,

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